

**REMARKS**

Claims 1-4, 9 and 12-13 were examined in the Final Office Action mailed August 8, 2007. The following objections and rejections are pending:

- Objection to lack of identification of the foreign priority application in the Oath/Declaration.
- Rejection of claims 1 and 9 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Publication No. US 2004/0094522 (“Hermann”).
- Rejection of claims 3-4 under § 103(a) as unpatentable over Hermann, in view of Japanese patent document JP 10-296472 (“Goto”).
- Rejection of claims 12-13 under § 103(a) as unpatentable over Hermann and Goto, further in view of U.S. Patent No. 6,399,915 to Mori, *et al.* (“Mori”).

The following remarks are respectfully submitted to address each issue.

**1. The Rules Do Not Require An Oath As To Priority.** The pending Office Action once again reasserts the objection to the oath/declaration as not identifying the foreign priority application by application number, country, day, month and year of filing. January 9, 2008 Office Action at 2. In the Applicant’s October 31, 2007 response, it was noted that 37 C.F.R. expressly does not require what the Examiner is currently seeking.<sup>1</sup> The present Office Action does not state

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<sup>1</sup> For the Examiner’s convenience, the previously presented argument is repeated below:  
The Applicant respectfully draws the Examiner’s attention to the provisions of 37 C.F.R. § 1.63(c). This rule subsection explicitly states that the oath or declaration must identify any foreign application for patent for which priority is made “**UNLESS** such information is supplied on an application data sheet in accordance with § 1.76.” (emphasis added). This is precisely how the Applicant provided the required priority information – in the ADS, not in the declaration, as permitted.

The Applicant further notes that there is no requirement in the rules that foreign priority data be attested to in the form of a formal oath or declaration (whether it is included with the rest of the information required in an oath/declaration, or it is included in an ADS). Indeed, this is what § 1.63 plainly contemplates, as nothing in § 1.63 (or in § 1.76, the ADS rule) begins to suggest the need for an oath for either the priority information or an application data sheet. Finally, the Applicant respectfully draws the Examiner’s attention to the fact that the form of submission of priority information in this case – in the ADS, not the declaration – is exactly the way priority

any further basis for the continued insistence on a citation to the priority document in the oath/declaration. The Applicant respectfully repeats his request for withdrawal of the objection to the oath/declaration, or at a minimum, at least a citation to some authority which overrides the plain language of 37 C.F.R. § 1.63 that would obviate the need for the Applicant to have to file a petition to resolve this issue.

**2. Claims 1 and 9 Are Patentable Over the Hermann Reference.**

The Applicant respectfully traverses the rejection of claims 1 and 9 under § 103(a) as unpatentable over Hermann the grounds that this reference does not disclose the claimed process gases.

Claim 1 recites a process for laser welding involving certain specified gases, utilizing the transitional phrase “consisting essentially of” – a phrase that the MPEP teaches “limits the scope of a claim to the specified materials or steps ‘and those that do not materially affect the basic and novel characteristic(s)’ of the claimed invention.” MPEP § 2111.03 (citing *In re Herz*, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original)).

The Hermann reference teaches in all forms of its process gases the use of Helium. *See, e.g.*, Hermann ¶ [0009] (“The invention solves this problem in that the process gas contains ... helium ... carbon dioxide ...”). There is no question that Helium is a process gas which can “materially affect the basic and novel characteristic(s)’ of a welding process. In contrast, by use of the transition phrase “consisting essentially of,” the Applicant has deliberately limited the

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information has been presented to the Office in untold thousands of patent applications over the

invention recited in claim 1 to process gases which exclude Helium. Because the claimed process gases cannot contain Helium, and Hermann teaches a process gas which always contains Helium, it would not have been obvious to use the Hermann's Helium-containing process gas as a foundation for the presently claimed Helium-excluding process gases. Claims 1 and 9 therefore are patentable over the Hermann reference under § 103(a).

Similarly, the Goto reference teaches a process gas in which Oxygen is an essential component, and it should be beyond question that a gas as highly reactive as Oxygen would “materially affect the basic and novel characteristic(s)” of the claimed invention.” As with Hermann, because Oxygen is expressly excluded from the claimed process gases by the “consisting essentially of” transitional phrase, Goto’s Oxygen-containing process gas cannot be a foundation for obtaining the presently claimed invention.

In view of the foregoing, the Applicant respectfully submits that Hermann, Goto and Mori, either alone or in any combination, cannot teach or suggest the Helium- and Oxygen-excluding laser welding process recited in claim 1 and its dependent claims 3-4, 9 and 12-13. Accordingly, reconsideration and withdrawal of the pending rejections based on the Hermann and Goto references is respectfully requested.

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years.

**CONCLUSION**

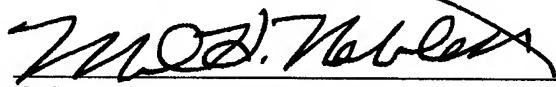
In view of the foregoing, the Applicant respectfully submits that claims 1, 3-4, 9 and 12-13 are in condition for allowance. Early and favorable consideration and issuance of a Notice of Allowance for these claims is respectfully requested.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #038724.52699US).

Respectfully submitted,

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